APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,835	12/17/1999	DON HIDEYASU MATSUBAYASHI	36J.P214	9385

5514 7590 07/08/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO	LUDWIG, MATTHEW J	
30 ROCKEFELLER PLAZA	ART UNIT	PAPER NUMBER
NEW YORK, NY 10112	2178	11

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-17,19,20,22,25,26,31 and 32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10-16,19,20,22,25,26,31 and 32* is/are rejected.

7)☒ Claim(s) *8 and 17* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 4/13/04.

2.   Claims 1-8, 10-17, 19, 20, 22, 25, 26, 31, and 32 are pending in the case. Claims 1, 6, 8,

10, 15, and 17 are independent claims. Claims 9, 18, 21, 23, 24, 27-30 have been cancelled.

3.   The rejection of claims 1-8, 10-17, 19, 20, 22, 25, 26, 31, and 32, under 35 U.S.C. 103(a)

as being unpatentable over Venkatraman has been withdrawn pursuant to the Applicant's

amendment.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   **Claims 1-7, 10-16, 19, 20, 22, 25, 26, 31, and 32 are rejected under 35 U.S.C. 103(a)**

as being unpatentable over Venkataman et al., USPN 5,956,487 filed (10/25/96).

In reference to independent claim 1, Venkatraman teaches:

A web server that dynamically generates a web page to reflect the updated state of the

information pertaining to the device. The web server functionality is embedded into the printer

device by providing software (compare to *"providing a web page from a printer's embedded*

web server to the web browser"). See column 4, lines 33-37 and column 4, lines 23-28. The web

browser includes a selection device that enables a user to select objects and URL links rendered

on the display (compare to "receiving a URL entered into the provided web page by the web

browser"). The reference demonstrates a method of receiving a URL defined in the HTML file

through the employment of the web browser, which is used to direct the users requests towards

other web pages for various printer support functions. See column 7, lines 1-21.

The reference further teaches URL's that are associated with hyperlinks. The hyperlinks

provide direct access to the Internet and make available a large organization network from which

a user would be able to search the World Wide Web and locate information regarding related

printer support functions.

The reference discloses a device with embedded web access functionality that provides

device-specific user interface functions. The device includes a network interface and a web

server along with a monitor. The device represents a wide variety of devices including devices

such as *printer*, fax machines, etc. It would have been obvious to one of ordinary skill in the art

at the time the invention was made to have modified the embedded web access mechanism in a

printer as taught by Venkatraman and printed information gathered via hyperlinks, because it

would have given the user the added benefit of enhanced and widely accessible user interface

functions that were employed in printer environments.

Venkatraman discloses the practice of utilizing the web page for the printer and

referencing manuals, parts lists, associated publications, etc. The methods suggest the receiving

and retrieval of documents through a web server. However, Venkatraman does not explicitly

teach automatically printing the retrieved document. Bobo teaches a message storage and

delivery system, which can automatically deliver facsimile messages to a user based on an

association of the user. See column 19, lines 5-56 and column 20, lines 1-35. The facsimile

messaging system performs similar processes as a printer and provides a means for automatically

printing of incoming messages based on an address from the user. It would have been obvious to

one of ordinary skill in the art, having the teachings of Venkatraman and Bobo before him at the

time the invention was made, to modify the printer web server techniques taught by

Venkatraman to include the automatic printing methods of Bobo, because it would have provided

the user with a fewer number of options in displaying or retrieving messages.

In reference to dependent claim 2, Venkatraman teaches:

The processor formats the information into the HTML format that defines the web page

and transfers the HTML formatted information to the web browser via the home-based network.

See column 6, lines 17-22.

In reference to dependent claim 3, Venkatraman teaches:

The reference demonstrates the utilization of HTML formatting language within the

embedded web access mechanism. See column 6, lines 17-22. The reference does not explicitly

teach a web page formatted in the XML format; however, the reference mentions the

employment of HTTP for communications in a client/server environment. It would have been

obvious to one of ordinary skill in the art at the time the invention was made, to modify the

HTML formatting techniques of Venkatraman and provided various extensions of the language

for use within a network environment, because it would have given the user the added benefit of

having structured data passed within a client/server device.

In reference to dependent claim 4 & 5, Venkatraman teaches:

Hyperlinks defined in the HTML file direct the web browser to other web pages for

various printer support functions. See column 7, lines 5-10. The reference discloses a device with

embedded web access functionality that provides device-specific user interface functions. The

device includes a network interface and a web server along with a monitor. The device represents

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a wide variety of devices including: printers, fax machines, appliances, etc. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the embedded web access mechanism in a printer as taught by Venkatraman and printer information gathered via hyperlinks, because it would have given the user the added benefit of enhanced and widely accessible user interface functions that were employed in printer environments.

In reference to dependent claim 6 & 15, Venkatraman teaches:

The web page may also contain one or more URL's that specify additional web pages located elsewhere, external to the device. The reference further discloses hyperlinks defined in the HTML file. The device methods taught by Venkatraman demonstrate a link to a document that represents printer support functions. See column 6, lines 1-30.

In reference to dependent claim 7, Venkatraman teaches:

The large organization network may be referred to as an Intranet and may be implemented with a variety of communication mechanisms including local area networks connected together by various types of communication links. See column 7, lines 23-29.

In reference to claims 10-14, 16, 19, 20, 22, 25, 26, 31, and 32, the claims recited similar limitations to those of claims 1-7, and therefore are rejected under similar rationale.

Allowable Subject Matter

Claims 8 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-8, 10-17, 19, 20, 22, 25, 26, 31, and 32 have been considered but are moot in view of the new ground(s) of rejection.

It is respectfully noted that applicant's incorporation of the newly formed limitations within the recited claims changes the scope of the invention when read as a whole. Therefore, the instant rejections have been adjusted accordingly.
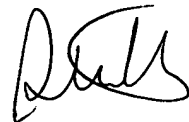
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 703-305-8043. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
June 25, 2004

STEPHEN S. HONG
PRIMARY EXAMINER